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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,897	03/22/2004	Hebah Ahmed	68.0274CNT(SHL.0231C1US)	1919

7590 04/14/2005  
Schlumberge Reservoir Completions  
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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
3672	

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/805,897

Applicant(s)

AHMED ET AL.

Examiner

Jennifer H Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-46 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 28-46 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

3. Claims 28-36 and 38-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Winter et al. (US 4,580,874).

*Regarding claims 28, 41:* Winter discloses an apparatus that includes the following features:

- A weld coupling 46 to be welded to an outer housing 16 of a first cable segment 14 (left-hand side of Figure 2) to couple the first cable segment to a second cable segment 14 (right-hand side of Figure 2).
- A thermal insulator 30 adapted to prevent thermal damage to the first cable segment when the weld coupling is welded to the outer housing.

*Regarding claim 29, 40:* The thermal insulator contacts the outer housing and indirectly contacts the cable segment (Figures 3-6).

*Regarding claims 30, 32, 42, 43:* The apparatus also includes a polymeric insulating material 18 separate from the thermal insulator and located between the outer housing and the cable segments. The thermal insulator near the weld coupling displaces the insulating material.

*Regarding claim 31:* The insulating material contacts the outer housing and the cable segments.

*Regarding claim 33:* The insulating material transverses an axial length of the first cable segment except where displaced the thermal insulator.

*Regarding claims 34, 42, 43:* The thermal insulator would prevent melting or outgasing of the insulating material.

*Regarding claim 35:* The thermal insulator is located closer to the weld coupling than the insulating material.

*Regarding claim 36:* The weld coupling is a sleeve approximately centered where the first segment contacts the second segment.

*Regarding claims 38, 39:* Winter further discloses a method for using that above apparatus that involves providing the weld coupling and preventing thermal damage to the cable segments by providing a thermal insulator between the outer housing and the cable segment.

*Regarding claims 44, 45:* The method further involves preventing thermal damage to the first and second cable segments when the weld coupling is welded to the outer housing.

4. Claims 28, 29, and 38-40 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

*Regarding claim 28:* Claims 1 and 2 of Application No. 10/449,496 recite a weld coupling to weld an outer housing of a first cable to couple a first and second cable segments and a reflective sleeve, the sleeve being a thermal insulator (claim 2), being located between the cable segments and the welds. Though claims 1 and 2 of Application No. 10/449,496 do not specifically stated that the thermal insulator is meant to prevent thermal damage the cable segments during the welding process, this is inherently what a thermal insulator in the claimed location would be for.

*Regarding claim 29:* Claims 1 and 2 of Application No. 10/449,496 do not specifically state that the thermal insulator is in contact with the outer housing and the communication line, i.e. the cable segments, however the thermal insulator would inherently be in contact with these features as it is recited that the thermal insulator is located between the outer housing and the welds.

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*Regarding claim 38 and 39:* Claim 40 of Application No. 10/449,496 includes all of the features and steps of claim 38 and 39 of the instant application. Though claim 40 of Application No. 10/449,496 do not specifically stated that the thermal insulator is meant to prevent thermal damage the cable segments during the welding process, this is inherently what a thermal insulator in the claimed location would be for.

*Regarding claim 40:* Claim 40 of Application No. 10/449,496 do not specifically state that the thermal insulator is in contact with the outer housing and the communication line, i.e. the cable segments, however the thermal insulator would inherently be in contact with these features as it is recited that the thermal insulator is located between the outer housing and the welds.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winter et al. (US 4,580,874).

Winter discloses all of the limitations of the above claims except for a second thermal insulator separate from the first thermal insulator for protecting the second cable segment. However, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have connected the second cable segment would be connected to a third cable segment at another location using the splice taught by Winter in order to have used a relatively simple splice to connect pieces of cable along the entire length of the cable (2:48-68). A second splice would include a second thermal insulator, separate from the first, for protecting the second cable segment.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 28 and 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 and 27 of copending Application No. 09/970,353. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 6 and 27 of Application No. 09/970,353 include all of the features, plus additional features, recited claims 28 and 38 of the instant application and could be used to reject the subject matter of claims 28 and 38 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 28, 38, and 39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 40 of copending Application No. 10/449,496. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 2, and 40 of Application No. 10/449,496

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include all of the features recited in claims 28, 38, and 39 of the instant application and could be used to reject the subject matter of claims 28, 38, and 39 of the instant application. It is noted that claims 1, 2, and 40 of Application No. 10/449,496 do not specifically recite that the thermal insulator contacts the outer housing and contacts the communication line but does recite that the thermal insulator, or reflective sleeve, is located between the two features.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

10. In view of applicant's amendment, the objection to the specification and the claims has been withdrawn. It is further noted that the statement in the previous Office Action regarding an objection to the abstract was incorrect; the abstract submitted with the previous response was accepted.

11. Applicant's arguments with respect to claims 28-46 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

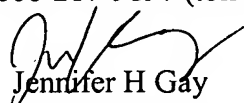
The remaining references made of record disclose various splices.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer H Gay  
Patent Examiner  
Art Unit 3672

JHG   
April 11, 2005